



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/054,749

01/18/2002

David G. Stork

015358-006710US

4058

20350

7590

06/20/2006

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

BHATIA, AJAY M

ART UNIT

PAPER NUMBER

2145

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/054,749

Applicant(s)

STORK ET AL.

Examiner

Ajay M. Bhatia

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-66 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-66 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date PTO 3/23/06  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

***Response to Arguments***

Applicant's arguments filed 4/24/06 have been fully considered but they are not persuasive.

In response to applicant's arguments addressing 101 rejection applicant is suggested to review the interim guidelines in the Official Gazette Notices dated 22 November 2005, under Guidelines for Subject Matter Eligibility. Specifically on page 12 of the specification applicant define (non-volatile) storage medium, and presently claims read as simply storage medium including both (volatile and non-volatile) memory, making the claimed invention transient and therefore non statutory.

Applicant present 3 arguments: (a) Detecting a refinable place in a first workflow network, (b) Determining if a second work network is permitted to be attached to the refinable place of the first workflow network, and (c) Attaching the second workflow network to the refinable place of the first workflow network. All of the presented arguments addressing the 102 rejection are dependant upon applicant the definition of "refinable." But on page 26 of applicants arguments applicant intentionally chooses not to define the term refinable on line 13 where applicant "refinement network may specify ..." applicant merely provides an example of a embodiments the specification capable of meeting the claim limitation. Additionally applicant has failed to provided any specific page and line number to define applicants interpretation of "refinable" therefore examiner must interpretation claim limitation as broadest possible interpretation of claim in view of the specification without importing limitations for the specification. Therefore

if the applicant wished to claim Petri nets applicant must amend claims to included Petri nets not just workflows, which is broader terminology. Therefore the present rejection Pareschi teaches the present claim limitation as interpreted in light of the specification.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 23-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Rejected claim(s) do not clearly define the claimed invention as a tangible embodiment therefore claim(s) are non-statutory. MPEP § 2105, states that an article of manufacture must be made from raw materials. Applicant is suggested to amend the claims in a form that meets 101 with support for terminology used in the specification.

Applicant is suggested to review the interim guidelines in the Official Gazette Notices dated 22 November 2005, under Guidelines for Subject Matter Eligibility.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 23, 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. "tangible" not supported by the specification, please use terminology enabled by the specification. Further clarification can be found in the interim guidelines.

Applicant is suggested to review the interim guidelines in the Official Gazette Notices dated 22 November 2005, under Guidelines for Subject Matter Eligibility.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-66 rejected under 35 U.S.C. 102(e) as being anticipated by Pareschi et al. (U.S. Patent 6,725,428).

For claim 1, Pareschi et al. teaches, a method of processing a document in a workflow system, the method comprising:

detecting when a document is at a refinable place in a first workflow network, the first workflow network specifying a plurality of operations to be performed on the document including a first operation and a second operation, the refinable place occurring at a location in the first workflow network after the first operation and before the second operation is performed on the document; (Pareschi., figures 4,12, Col. 10 lines 36-46)

determining, when the document is at the refinable place, if a second workflow network specified by the document is permitted to be attached to the refinable place of the first workflow network, the second workflow network specifying one or more operations to be performed on the document; (Pareschi., Col. 10 lines 36-46, Col. 11 lines 24-38)

and if the second workflow network specified by the document is permitted to be attached to the refinable place of the first workflow network, attaching the second workflow network to the refinable place of the first workflow network such that the document is processed according to the second workflow network before the second operation specified by the first workflow network is performed on the document. (Pareschi., Col. 10 lines 36-46, Col. 11 lines 24-38)

For claim 2, Pareschi et al. teaches, the method of claim 1 wherein the first workflow network is configured by a workflow designer and the second workflow network is configured by an author of the document. (Pareschi., Col. 8 lines 57-65, Col. 9 lines 30-44)

For claim 3, Pareschi et al. teaches, the method of claim 1 wherein detecting when the document is at the refinable place in the first workflow network comprises:

detecting when the first operation has been performed on the document.

(Pareschi., Col. 11 line 56 to Col. 12 line 5)

For claim 4, Pareschi et al. teaches, the method of claim 1 wherein determining if the second workflow network specified by the document is permitted to be attached to the refinable place of the first workflow network comprises:

determining permissions information specified for the refinable place; (Pareschi., Col. 10 lines 1-5, Col. 11 line 56 to Col. 12 line 5)

and determining that the second workflow network specified by the document is permitted to be attached to the refinable place of the first workflow if the document satisfies the permissions information specified for the refinable place. (Pareschi., Col. 10 lines 1-5)

For claim 5, Pareschi et al. teaches, the method of claim 4 wherein the permissions information specified for the refinable place is configured by a designer of the first workflow network. (Pareschi., Col. 10 lines 1-5, Col. 9 lines 30-44)

Art Unit: 2145

For claim 6, Pareschi et al. teaches, the method of claim 1 wherein determining if the second workflow network specified by the document is permitted to be attached to the refinable place of the first workflow network comprises:

determining permission information associated with the document; (Pareschi., Col. 10 lines 1-5)

and determining that the second workflow network specified by the document is permitted to be attached to the refinable place of the first workflow if the permission information associated with the document permits the attachment. (Pareschi., Col. 10 lines 1-5, Col. 9 lines 30-44)

For claim 7, Pareschi et al. teaches, the method of claim 6 wherein the permissions information associated with the document is configured by an author of the document. (Pareschi., Col. 10 lines 1-5, Col. 9 lines 30-44)

For claim 8, Pareschi et al. teaches, the method of claim 1 wherein attaching the second workflow network to the refinable place of the first workflow network such that the document is processed according to the second workflow network before the second operation specified by the first workflow network is performed on the document comprises:

performing at least one operation from the one or more operations specified by the second workflow network on the document before performing the second operation

Art Unit: 2145

specified by the first workflow network on the document. (Pareschi., Col. 10 lines 1-5, Col. 11 line 56 to Col. 12 line 5)

For claim 9, Pareschi et al. teaches, the method of claim 1 wherein attaching the second workflow network to the refinable place of the first workflow network such that the document is processed according to the second workflow network before the second operation specified by the first workflow network is performed on the document comprises:

identifying a set of one or more workflow networks specified by the document;  
(Pareschi., Col. 10 lines 1-5)

identifying a workflow network from the set of workflow networks that satisfies a selection criterion; (Pareschi., Col. 10 lines 1-5)

and processing the second document according to the workflow network identified from the set of workflow networks before performing the second operation specified by the first workflow network on the document. (Pareschi., Col. 10 lines 1-5)

For claim 10, Pareschi et al. teaches, the method of claim 1 wherein the second workflow network attached to the refinable place of the first workflow network comprises a refinable place. (Pareschi., Col. 6 lines 30-41)

For claim 11, Pareschi et al. teaches, the method of claim 1 further comprising:

if the second workflow network specified by the document is not permitted to be attached to the refinable place of the first workflow network:

determining a set of workflow networks attached to the refinable place of the first workflow network; (Pareschi., Col. 10 lines 1-13)

identifying at least one workflow network from the set of workflow networks for processing the document; (Pareschi., Col. 10 lines 1-5)

and processing the document according to the at least one workflow network before performing the second operation specified by the first workflow network on the document. (Pareschi., Col. 9 lines 57-61)

For claim 12, Pareschi et al. teaches, the method of claim 1 further comprising:

if the second workflow network specified by the document is not permitted to be attached to the refinable place of the first workflow network:

determining a first set of workflow networks attached to the refinable place of the first workflow network; (Pareschi., Col. 10 lines 1-5)

based upon permissions information associated with the document, detaching one or more workflow networks included in the first set of workflow networks from the refinable place such that a second set of workflow networks remain attached to the refinable place; (Pareschi., Col. 11 line 56 to Col. 12 line 5)

identifying at least one workflow network from the second set of workflow networks for processing the document; (Pareschi., Col. 10 lines 1-5)

and processing the document according to the at least one workflow network before performing the second operation specified by the first workflow network on the document. (Pareschi., Col. 10 lines 1-13)

For claim 13, Pareschi et al. teaches, a method of processing a document according to a first workflow network, the first workflow network specifying a plurality of operations to be performed, the plurality of operations including a first operation and a second operation following the first operation, the method comprising:

subsequent to performing the first operation and before performing the second operation, determining if the document is permitted to be processed by a second workflow network specified by the document, the second workflow network specifying one or more operations to be performed on the document; (Pareschi., Col. 10 lines 1-5, Col. 10 lines 36-46, figures 4, 12)

and if the document is permitted to be processed by the second workflow network, processing the document according to the second workflow network before the second operation specified by the first workflow network is performed. (Pareschi., Col. 10 lines 1-13, Col. 11 line 56 to Col. 12 line 5)

For claim 14, Pareschi et al. teaches, the method of claim 13 wherein the first workflow network is configured by a workflow designer and the second workflow network is configured by an author of the document. (Pareschi., Col. 10 lines 1-5)

For claim 15, Pareschi et al. teaches, the method of claim 13 wherein determining if the document is permitted to be processed by the second workflow network specified by the document comprises:

determining permissions information specified for the first workflow network;  
(Pareschi., Col. 10 lines 1-5)

and determining that the document is permitted to be processed by the second workflow network if the document satisfies the permissions information specified for the first workflow network. (Pareschi., Col. 10 lines 1-13, Col. 11 line 56 to Col. 12 line 5)

For claim 16, Pareschi et al. teaches, the method of claim 15 wherein the permissions information specified for the first workflow network is configured by a designer of the first workflow network. (Pareschi., Col. 10 lines 1-5)

For claim 17, Pareschi et al. teaches, the method of claim 13 wherein determining if the document is permitted to be processed by the second workflow network specified by the document comprises:

determining permissions information associated with the document; (Pareschi., Col. 10 lines 1-5)

and determining if the document is permitted to be processed by the second workflow network specified by the document based upon the permissions information associated with the document. (Pareschi., Col. 10 lines 1-5)

For claim 18, Pareschi et al. teaches, the method of claim 17 wherein the permissions information associated with the document is configured by an author of the document. (Pareschi., Col. 10 lines 1-5, Col. 9 lines 30-44)

For claim 19, Pareschi et al. teaches, the method of claim 13 wherein processing the document according to the second workflow network comprises:

identifying a set of one or more workflow networks specified by the document' 5  
identifying a workflow network from the set of workflow networks that satisfies a selection criterion; (Pareschi., Col. 10 lines 1-5)

and processing the second document according to the workflow network identified from the set of workflow networks before performing the second operation specified by the first workflow network. (Pareschi., Col. 10 lines 1-13)

For claim 20, Pareschi et al. teaches, the method of claim 13 wherein processing the document according to the second workflow network comprises:

performing at least one operation from the one or more operations specified by the second workflow network before performing the second operation specified by the first workflow network. (Pareschi., Col. 11 line 56 to Col. 12 line 5)

For claim 21, Pareschi et al. teaches, the method of claim 13 further comprising:

if the document is not permitted to be processed by the second workflow network:

identifying a set of workflow networks; (Pareschi., Col. 11 lines 24-38)

identifying at least one workflow network from the set of workflow networks for processing the document; (Pareschi., Col. 10 lines 36-46, Col. 11 lines 24-38, figures 4, 12)

and processing the document according to the at least one workflow network before performing the second operation specified by the first workflow network.  
(Pareschi., Col. 11 lines 24-38)

For claim 22, Pareschi et al. teaches, the method of claim 13 further comprising:

if the document is not permitted to be processed by the second workflow network:

identifying a first set of workflow networks; (Pareschi., Col. 10 lines 36-46, //s 4,12)

based upon permissions information associated with the document, deleting one or more workflow networks from the first set of workflow networks; (Pareschi., Col. 10 lines 1-13)

identifying at least one workflow network from workflow network remaining in the first set of workflow networks for processing the document; (Pareschi., Col. 10 lines 36-46, Col. 11 Col. 24-38, Col. 10 lines 1-13)

and processing the document according to the at least one workflow network before performing the second operation specified by the first workflow network.  
(Pareschi., Col. 11 lines 24-38)

Claims 44-66 list all the same elements of claims 1-22, but in product and system form rather than method form. Therefore, the supporting rationale of the rejection to claims 1-22 applies equally as well to claims 44-66.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached Notice of references cited (if appropriate).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay M. Bhatia whose telephone number is (571)-272-3906. The examiner can normally be reached on M-F 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571)272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason Cardone  
Supervisor Patent Examiner  
Art Unit 2145

AB